

10/746,903

PATENTAMENDMENT A (IN RESPONSE TO PAPER NO. 7
(OFFICE ACTION DATED MAY 24, 2004))REMARKS

Claims 1-14 are pending in this case. Claims 6, 7 and 11 have been amended to correct typographical errors. Based upon the following remarks, it is respectfully submitted that claims 1-14 are allowable.

A. §103 Rejection of Claims Based on Kohlschmidt

Claims 1-3 were rejected under 35 U.S.C. §103(a) as being unpatentable over Kohlschmidt, U.S. Patent No. 6,029,061 ("Kohlschmidt"). This rejection is respectfully traversed.

It is respectfully submitted that the bases for the rejection of the claims as set forth in the Office Action do not adequately identify the issues and as a result do not provide a fair opportunity to reply to them. See M.P.E.P. 706.02(j). For example, in the first sentence of the substantive discussion of this rejection, it is stated (with emphasis added): "Kohlschmidt discloses receiving a first plurality of frame programs (repeating frames/slots in a TDMA/GSM environment[,], col. 6, lines 56-67; 'normal mode', Fig. 5),". Then in the last sentence of this same discussion, it is stated (with emphasis added): "Kohlschmidt fails to particularly call for a frame program, and a plurality of frame programs, as specified in claim 1." Such statements are contradictory. Moreover, the citation(s) to col. 6, lines 56-67, and Figure 5 of Kohlschmidt are not understood. First, col. 6, lines 56-67, contain discussion directed to Figure 3, not Figure 5. Second, a reading of lines 56-67 of each of columns 1, 2, 3, 4, 5, 6, 7, 8, 9, 10, 11 and 12 revealed no occurrence of any of the terms "frames", "slots" or "frame programs". Accordingly, it is respectfully submitted that the issues have not been adequately identified and, as a result, a fair opportunity to reply has not been provided.

Further, the disclosure of Kohlschmidt is expressly directed to subject matter which is quite distinct from that which is presently claimed. As is clearly set forth in the Abstract, as well as is apparent from the claims, Kohlschmidt is

Atty. Docket No.: P04793 (11461.00.0076) - 6 -
CHICAGO/#1267181.1

10/746,903

PATENTAMENDMENT A (IN RESPONSE TO PAPER NO. 7
(OFFICE ACTION DATED MAY 24, 2004))

directed to a power saving technique with which a time base is maintained during inactive modes of operation using a lower power "slow clock" that had been synchronized to the higher power "fast clock" prior to entry into the low power inactive mode of operation. In contrast thereto, the presently claimed invention includes, among other limitations, the use of interrupts in conjunction with programming of distinct memory regions with different frame programs. Kohlschmidt neither teaches nor suggests such subject matter. The Examiner did state that the presently recited frame programs are not defined as being different; however, this is respectfully disputed since the recitations expressly include "first" and "second" frame programs, and the term "second frame program" is also preceded by the indefinite article "a" as opposed to the definite article "the".

Accordingly, it is respectfully requested that, if the Examiner, upon reconsideration, still considers the presently claimed invention to be unpatentable over the cited references, a second non-final Office Action be issued with a properly detailed presentation of the bases for the rejection of the claims so as to provide a fair opportunity for reply.

B. §103 Rejection of Claims Based on Kohlschmidt & Levy

Claims 1-3 were further rejected under 35 U.S.C. §103(a) as being unpatentable over Kohlschmidt in view of Levy, U.S. Patent No. 5,524,008 ("Levy"). This rejection is respectfully traversed.

As discussed above in Part A, it is respectfully submitted that the issues regarding these claims have not been adequately identified or otherwise addressed. Accordingly, it is submitted that until then any further remarks about these same claims in the context of Kohlschmidt with the addition of Levy would be premature and may potentially cause the scope of such claims to become unnecessarily limited.

Atty. Docket No.: P04793 (11461.00.0076) - 7 -
CHICAGO/#1267181.1

10/746,903

PATENTAMENDMENT A (IN RESPONSE TO PAPER NO. 7
(OFFICE ACTION DATED MAY 24, 2004))C. §103 Rejection of Claims Based on Kohlschmidt, Levy & Weigand

Claims 6-8 and 11-13 were rejected under 35 U.S.C. §103(a) as being unpatentable over the previously cited combination of Kohlschmidt and Levy in view of Weigand, U.S. Patent No. 5,822,308 ("Weigand"). This rejection is respectfully traversed.

It is respectfully submitted that, at a minimum, independent claims 6 and 11 address subject matter similar to that of independent claim 1, such as the use of interrupts in conjunction with programming of distinct memory regions with different frame programs. With reference to the discussion above in Part A, it is further submitted that the issues regarding claim 1, and therefore at least claims 6 and 11 as well, have not been adequately identified or otherwise addressed. Accordingly, it is submitted that until then any further remarks about these same claims in the context of Kohlschmidt with the addition of Levy and Weigand would be premature and may potentially cause the scope of such claims to become unnecessarily limited.

D. Allowable Claims

Claims 4-5, 9-10 and 14 were objected to as being dependent upon rejected base claims but were identified as being allowable if rewritten in independent form including all of the limitations of the base claims and any intervening claims. It is respectfully submitted that until the issues regarding the base claims and any intervening claims are adequately identified and addressed, as discussed above, any rewriting of these claims to appear in independent form would be premature and may potentially cause the scope of such claims to become unnecessarily limited.

E. Conclusion

Claims 1-14 remain pending in this case. Based upon the foregoing, it is

Atty. Docket No.: P04793 (11461.00.0076) - 8 -
CHICAGO/#1267181.1

10/746,903


PATENT

AMENDMENT A (IN RESPONSE TO PAPER NO. 7
(OFFICE ACTION DATED MAY 24, 2004))

respectfully submitted that these claims are allowable, and reconsideration and
early allowance of these claims are requested.

Respectfully submitted,

VEDDER, PRICE, KAUFMAN & KAMMHOLZ, P.C.

Date: August 16, 2004 By: 
Mark A. Dalla Valle
Reg. No. 34,147

Attorney for Assignee
222 N. LaSalle St., 24th Floor
Chicago, IL 60601
312-609-7500
Customer No.: 23,418